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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,965	10/10/2000	Yuki Uchida	197849US-28	4230

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

DUONG, THOMAS

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 02/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,965

Applicant(s)

UCHIDA ET AL.

Examiner

Thomas Duong

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5-7</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 13, 25, 37, 42 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Becker et al. (US006658452B1).
3. With regard to *claims 1, 13 and 25*, Becker reference discloses,
 - *receiving a request (application selection) from a remote user (clients 110-114 at the application provider server 104);* (Becker, abstract; col.2, lines 29-47; col.2, line 66 – col.3, line 12; col.4, lines 10-25; col.5, lines 17-26, lines 27-39; fig.1; fig.3-7)
 - *selecting an application service provider (server 104 to access suites of applications) based on said request;* (Becker, abstract; col.2, lines 29-47; col.2, line 66 – col.3, line 12; col.4, lines 10-25; col.5, lines 17-26, lines 27-39; fig.1; fig.3-7)

- *forwarding said request to said application service provider; and (Becker, abstract; col.2, lines 29-47; col.2, line 66 – col.3, line 12; col.4, lines 10-25; col.5, lines 17-26, lines 27-39; fig.1; fig.3-7)*
- *receiving information from said application service provider indicating information of a document provided from said application service provider to said user. (Becker, col.5, lines 40-62; col.5, line 63 – col.6, line 5; col.6, lines 6-48; fig.4-7)*

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. *Claims 2-8, 11-12, 14-20, 23-24, 26-32 and 35-36* are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al. (US006658452B1) and in view of Britton (US006591289B1).

6. With regard to *claims 2, 5-7, 11-12, 14, 17-19, 23-24, 26, 29-31 and 35-36*, Becker reference discloses the invention substantially as claimed,

See claims 1, 13 and 25 rejection as detailed above.

However, Becker reference does not explicitly disclose,

- *further comprising the step of providing said user with said document from said application service provider.*

- *wherein the step of providing said document to said user comprises:*
 - *delivering a print out of said document to said user; and*
 - *providing said user with a URL of said document.*
- *wherein the step of providing said document to said user comprises transmitting said document to a user storage device.*
- *wherein the step of providing said document to said user comprises transmitting said document to a user display device*

Britton teaches,

- *further comprising the step of providing said user with said document from said application service provider. (Britton, abstract; col.2, lines 13-32; col.3, line 56 - col.4, line 38; col.5, lines 53-65)*
- *wherein the step of providing said document to said user comprises:*
 - *delivering a print out of said document to said user; and (Britton, abstract; col.2, lines 13-32; col.3, lines 37-53; col.3, line 56 - col.4, line 38; col.5, lines 53-65)*
 - *providing said user with a URL of said document. (Britton, abstract; col.2, lines 13-32; col.3, line 56 - col.4, line 38; col.5, lines 53-65; col.6, line 45 – col.7, line 12)*
- *wherein the step of providing said document to said user comprises transmitting said document to a user storage device. (Britton, abstract; col.2, lines 13-32; col.3, line 56 - col.4, line 38; col.5, lines 53-65; col.6, line 45 – col.7, line 12; col.9, lines 28-45; col.10, lines 34-38)*

- *wherein the step of providing said document to said user comprises transmitting said document to a user display device (Britton, abstract; col.2, lines 13-32; col.3, line 56 - col.4, line 38; col.5, lines 53-65; col.6, line 45 – col.7, line 12; col.9, lines 28-45)*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Britton reference with Becker reference to further enhance the delivering of formatted document for viewing over a communications network, such as the internet, wherein information contained in the document is arranged into a pre-determined layout or file format upon request by the client.

7. With regard to *claims 3-4, 8, 15-16, 20, 27-28 and 32*, Becker and Britton references discloses the invention substantially as claimed,

See claims 1, 13 and 25 rejection as detailed above.

However, Becker reference does not explicitly disclose,

- *further comprising the step of providing said application service provider with a user access level.*
- *further comprising the step of searching for said document in said application service provider.*
- *further comprising the steps of*
 - *retrieving said document;*
 - *formatting said document into a format requested by said user;*

- *providing said user with said document formatted in said formatting step.*

Britton teaches,

- *further comprising the step of providing said application service provider with a user access level. (Britton, col.8, lines 33-54; col.10, lines 12-14)*
- *further comprising the step of searching for said document in said application service provider. (Britton, abstract; col.2, lines 13-32; col.3, line 56 - col.4, line 38; col.5, lines 53-65; col.6, line 45 – col.7, line 12; col.9, lines 28-45; col.10, lines 34-38)*
- *further comprising the steps of*
 - *retrieving said document; formatting said document into a format requested by said user; providing said user with said document formatted in said formatting step. (Britton, col.3, lines 10-36; col.10, lines 10-19; col.17, lines 56-57)*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Britton reference with Becker reference to further enhance the delivering of formatted document for viewing over a communications network, such as the internet, wherein information contained in the document is arranged into a pre-determined layout or file format upon request by the client.

8. Claims 9-10, 21-22 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al. (US006658452B1), in view of Britton (US006591289B1) and further in view of Smith (US006385655B1).
9. With regard to *claims 9-10, 21-22 and 33-34*, Becker and Britton references disclose the invention substantially as claimed,

See *claims 1-2, 13-14 and 25-26* rejection as detailed above.

However, Becker and Britton references do not explicitly disclose,

- *further comprising the steps of*
 - *generating a unified bill from bills received from application service providers; and*
 - *transmitting said unified bill to said user.*
- *wherein the receiving information step comprises receiving the information which is a billing information.*

Smith teaches,

- *further comprising the steps of*
 - *generating a unified bill from bills received from application service providers; and transmitting said unified bill to said user. (Smith, abstract; col.3, lines 37-44; col.7, lines 60-67)*
- *wherein the receiving information step comprises receiving the information which is a billing information. (Smith, abstract; col.3, lines 37-44; col.7, lines 60-67)*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Smith reference with Becker and Britton references to further enhance the delivering controlled of formatted document for accounting purposes over a communications network, such as the internet, wherein information contained in the document is arranged into a pre-determined layout or file format upon request by the client.

10. With regard to *claims 38-41, 43-46 and 48-51*, they include features or limitations as in *claim 9*. Thus, *claims 38-41, 43-46 and 48-51* are also rejected under the same rational as cited in the rejection of the *claim 9*.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
- Griffiths et al. (US006286045B1)
 - Grout (US005913033A)
 - Cox et al. (US006510466B1)
 - Davis et al. (US006615233B1)
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Duong whose telephone number is


703/305-1886. The examiner can normally be reached on M-F 7:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 703/308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are 703/872-9306 for regular communications and 703/872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/305-3900.

Thomas Duong (AU2143)

February 10, 2004


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100